

**REMARKS**

Claims 1-21 are all the claims pending in the application. Claims 1-6 have been amended. Claims 16-21 have been added.

**I. Claim Rejections under 35 U.S.C. § 102**

Claims 1-15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Vinciarelli et al. (U.S. Patent No. 6,847,853). Applicant respectfully traverses the rejection.

First, Applicant respectfully submits that the Examiner's rejection is improper in view of 37 C.F.R. § 1.104(c)(2) which reads as follows:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a Reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

In the Office Action, the Examiner, in making the rejections, merely reproduces the claims and generally asserts that they are all disclosed by Figures 1-35B and the description of Vinciarelli, **without pointing out any particular parts of the 46 pages of drawings and the 23 pages of specification of Vinciarelli that are relied on in support of the rejection.**

Applicant respectfully submits that the Examiner has failed to comply with the Examiner's duty under 37 C.F.R. § 1.104(c)(2). Vinciarelli is a divisional application including 23 pages of specification and 46 pages of drawing figures. Based on the fact that Vinciarelli is a divisional application, Applicant respectfully submits that the disclosure of Vinciarelli contains multiple inventions. Because Vinciarelli contains multiple inventions and the disclosure includes 23 pages of specification and more than 46 drawing figures, it can be concluded, and Applicant

respectfully submits, that Vinciarelli is a complex reference. As such, the Examiner has failed to comply with the Examiner's duty to cite with particularity and to set forth the pertinence of the complex Vinciarelli reference. Accordingly, Applicant respectfully submits that the rejections are improper.

Further, even ignoring the fact that the rejections are improper, Applicant respectfully submits that the Vinciarelli reference still fails to teach or suggest each and every limitation of the claims.

In particular, Applicant respectfully submits that Vinciarelli fails to teach or suggest at least the following limitation of claim 1:

determination result storage means for storing a  
determination result obtained by the design result  
determination means

In the Office Action, the Examiner fails to cite any teaching or suggestion of Vinciarelli for the above recited claim limitation. Further, Applicant's own review of the reference has failed to find any disclosure of Vinciarelli that could be said to teach or suggest this limitation of the claim. Accordingly, Applicant respectfully submits that Vinciarelli fails to teach or suggest at least the above recited limitation of claim 1. Applicant further respectfully submits that claims 3 and 5 each recite similar limitations which Vinciarelli also fails to teach or suggest. As such, Applicant respectfully submits that Vinciarelli fails to teach or suggest each and every limitation of the claims.

Accordingly, Applicant respectfully submits that claims 1, 3 and 5 are not anticipated under 35 U.S.C. § 102(b) by Vinciarelli, because the reference does not disclose all of the features and limitations of the claims. Accordingly, Applicant respectfully requests that the

Examiner withdraw the rejection of claims 1, 3 and 5, and claims 2, 4 and 6-15 at least by virtue of their dependency from claims 1, 3 and 5.

**II. New Claims**

New claims 16-21 have been added. Applicant respectfully submits that these new claims are patentable over the prior art at least by virtue of their dependence from claims 1, 3 and 5.

**III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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